

behavior, wherein the composition comprises an aqueous medium classified in class 424, subclass 401.

II. Claims 4[9]-67 are, drawn to a composition comprising, in a physiologically acceptable medium, rigid fibres and at least one compound chosen from film-forming polymers and waxes, wherein the composition has a thixotropic plastic behavior, wherein the composition comprises a liquid fatty phase classified in class 514, subclass + depending on the nature of the fatty phase.

III. Claims 97-99 are, drawn to a cosmetic method for making up and caring for keratinous materials comprising applying to keratinous materials a composition comprising, in a physiologically acceptable medium, substantially rectilinear rigid fibres and at least one compound chosen from film-forming polymers and waxes, wherein the composition has a thixotropic plastic behavior *or* a method for obtaining a homogenous deposit on keratinous materials, comprising applying to the keratinous materials a composition comprising, in a physiologically acceptable medium, substantially rectilinear rigid fibres and at least one compound chosen from film-forming polymers and waxes, wherein the composition has a thixotropic plastic behavior, classified in class 424, subclass 70.7.

IV. Claim 100 is, drawn to a method for obtaining a lengthening effect of eyelashes comprising, applying to the eyelashes a composition comprising, in a physiologically acceptable medium, substantially rectilinear rigid fibres and at least one compound chosen from film-forming polymers and waxes, wherein the composition has a thixotropic plastic behavior, classified in class 424, subclass 70.7.

Dec. 14, 2006, Office Action, at 2-3 (emphasis in original).¹

Applicant respectfully traverses the restriction requirement, as set forth above and on pages 2-6 of the Office Action. However, to be fully responsive, Applicant

¹ In the restriction requirement, the Examiner identified Group II as covering claims 46-67. See Dec. 14, 2006, Office Action, at 2. Applicant believes, however, that the Examiner intended to

elects, with traverse, the subject matter of Group II, comprising claims 49-67.

In addition, the Examiner asserts that the present claims are “directed to the following patentably distinct species: belonging to at least one compound, which can be wax or film forming polymers[,]” which, according to the Examiner, “[t]he wax can be any wax of claim 80[,]” and “[t]he film-forming polymer can be vinyl polymers, or acrylic polymers, or polyurethanes, or polyesters, or polyamides, or polyureas, or cellulosic polymers.” *Id.* at 6. The Examiner further asserts that the present claims are “directed to the following patentably distinct species: belonging to rigid fibers.” *Id.* at 8. The Examiner thus requires Applicant to elect a “single disclosed species belonging to wax or film forming polymer” and to elect a “single disclosed species belonging to rigid fibers.” *Id.* at 6, 8. Applicant respectfully traverses these election requirements as set forth on pages 6-8 of the Office Action. However, to be fully responsive, Applicant elects, with traverse, the “species” drawn to vinyl polymers as “film forming polymers” and aromatic polyimide-amide fibers as “belonging to rigid fibers.” The Examiner asks for “a listing of all claims readable” on the election of species. *Id.* at 7-8. Thus, Applicant notes that all claims of the restricted Group, i.e., claims 49-67, are readable thereon.

The Examiner admits that “[i]nventions I and II and III-IV are related as product and process of use.” *Id.* at 3. However, the Examiner asserts that the inventions are

identify Group II as covering claims 49-67, in view of Group I covering claims 41-48. Thus, for purposes of this response, Applicant has defined Group II as covering claims 49-67.

distinct because, with respect to Groups I-IV, the Examiner asserts that “[i]n the instant case the process for using the product as claimed can be practiced with polyamide gelling agent [sic].” *Id.* at 3. With respect to Groups I and II, “the inventions as claimed do not overlap in scope[, and] the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.” *Id.* at 3-4. Applicant disagrees.

Applicant respectfully refers the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P instructs the Examiner as follows:

If the search and examination of all the claims in an application can be made **without serious burden**, the examiner **must** examine them on the merits, even though they include claims to independent or distinct inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining Groups I-IV together would constitute a serious burden. Rather, the Examiner admits that Groups I-IV are related as: product and process of use. See Dec. 14, 2006, Office Action, at 3. The Examiner contends that the above related groups can also be distinct, but does not specify what serious burden will be placed on the Examiner if she were to proceed in examining the groups together, as required by M.P.E.P. § 803.

Further, Applicant respectfully submits that, at a minimum, examining the claims of Groups III-IV together would not impose a serious burden. M.P.E.P. § 803 states that “a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification.” In contrast, the Examiner indicates

that Groups III and IV fall into the same “class 424, subclass 70.7.” Dec. 14, 2006, Office Action, at 2-3.

Additionally, Applicant submits no serious burden would exist in light of the requirement of rejoinder. See M.P.E.P. § 821.04. Accordingly, it is unclear what burden is on the Examiner to examine at least the claims of Groups III-IV together, and Applicant respectfully requests withdrawal of the restriction requirement.

Moreover, Applicant respectfully traverses the election of species requirement, at least because the Examiner, similar to the Restriction Requirement, has failed to show that a serious burden exists to examine all of the alleged species. To make a proper requirement for an election of species the Examiner must, inter alia, show that the search and examination of a claim would impose a serious burden on the Office because it embraces an unreasonable number of species. M.P.E.P. § 803.02 (emphasis added). Here, the Examiner has provided no reasons or evidence on the record to substantiate the election of species requirement, let alone how examination of all the species would impose a serious burden. It can hardly be said that the waxes listed in claim 80 (belonging to wax), that the seven alleged species (belonging to film forming polymers), or that the possible species belonging to rigid fibers amount to an “unreasonable” number. Thus, there is truly no burden on the Examiner to examine the three defined species together.

If the Examiner chooses to maintain the election of species requirement, Applicant expects the Examiner, if the elected species is found allowable, to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to a “reasonable” number


of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121. Accordingly, it is unclear what burden is on the Examiner to examine all claimed species together, and Applicant respectfully requests withdrawal of the Restriction Requirement.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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